UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/419,856	10/19/99	MAPLES	D 2696

IM62/1201

GINNIE C DERUSSEAU
CHASE & YAKIMO LC
4400 COLLEGE BOULEVARD SUITE 130
OVERLAND PARK KS 66211

EXAMINER	
RAJGURU,U	
ART UNIT	**PAPER NUMBER**
1711	6

DATE MAILED: 12/01/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	Examiner	Group Art Unit	

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE — 3 — MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on Jul 21, 2000 (paper no 5).

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☐ Claim(s) 1-10 and 12-16 is/are pending in the application.

Of the above claim(s)_____ is/are withdrawn from consideration.

☐ Claim(s)_____ is/are allowed.

☒ Claim(s) 1-10 and 12-16 is/are rejected.

☐ Claim(s)_____ is/are objected to.

☐ Claim(s)_____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on_____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on_____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number)_____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received:_____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other_____

Office Action Summary

1. An amendment and a declaration have been filed on June 21, 2000 (paper no. 5).

MKR Rejection of claim 10 under 35 U.S.C. 112, second paragraph (see p. 2, ~~sectional~~ section 1 of prior action, paper no. 3) is now withdrawn. That of claim 11 (as per section 2 of same page) is moot since that claim is now cancelled.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 15 and 16 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specification fails to support the newly added limitation "low smoke" in these claims.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "low smoke" in claims 15 and 16 is a relative term which renders the claim indefinite. The term "low smoke" is not defined by the claim, the specification does not provide

a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is not known how much low, the smoke should be as encompassed by these claims.

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-10, 12-15 and (newly added) 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scholze et al (USP 5749948) in view of von Bonin et al (USP 4992481) and Fulmer (USP 4349494) further in view of Trocino et al (USP 5162394) and Shore (USP 5618605).

These rejections are incorporated here by reference from prior office action paper no. 3, pages 3-5, sections 3-5.

Applicant's arguments filed July 21, 2000 (paper no. 5) have been fully considered but they are not persuasive.

In response to applicant's argument that "there is no indication in Scholz that the composition (of Scholz) can be used as a low smoke fire retardant ~~carct~~ carpet backing" (page 6, of about response viz/paper no 5, paragraph 1), the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

It is the examiner's position that the instant invention is based on the composition disclosed by prior art and that it has been used for a purpose which is different from for which the composition of prior art is used.

On page 7, paragraph 1 of the same paper the applicants refer to a declaration by Dr. Johnson. The said declaration has been fully considered. It surely does contain important data. However it ~~is~~ does not carry any probative value to establish the nonobviousness of instant invention because it is not in commensurate in scope with the prior art. ~~The declaration takes into account the disclosure of only Scholz while the prior art encompasses the combined diselosures of Scholz and other secondary references~~.

On page 9, paragraph 1, of the same paper, the applicants argue that "this broad reference by von Bonin provides the artisan with no additional information as to how this material could be selected". This argument is not persuasive because an artisan does not need any more information.

"Von Bonin would not be consulted to produce a low smoke fire retardant carpet backing composition" (p. 10, paragraph 2 of same paper).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the applicants' arguments against the use of Fulmer, Trocino and Shore (pages 10, 11 & 12, of the same paper) are also not persuasive.

It is the examiner's position that the prior does disclose the claimed composition containing claimed ingredients which are present in amounts that either read on or overlap those that are instantly claimed. The applicants have found a new use for an already known composition.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to U.K. Rajguru whose telephone number is (703) 308-3224. The examiner can normally be reached on Monday - Friday from 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck, can be reached on (703) 308-2462. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

U.K. Rajguru/om
November 25, 2000

James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700